

Application No. 09/927,891
After Final Office Action of November 17, 2005

Docket No.: 59184/P002US/10026564

REMARKS

Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in view of the remarks contained herein. Claims 1, 4, 5, 31, 45 and 54 have been amended. Claims 1-21, 30-40, 45-52 and 54-60 are pending in this application.

Interview Summary

Applicant thanks the Examiner for his time and consideration at the in-person interview on January 25, 2006. Applicant and the Examiner discussed the current rejection of the independent claims and proposed amendments to the independent claims to overcome the rejections of record.

Rejection under 35 U.S.C. § 103 (Shennib in view of Toht)

Claims 1-19, 21, 30-39, 45-47, 49, 51, 52, 54-57 and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,701,348 to Shennib et al. (hereinafter, "Shennib") in view of U.S. Patent No. 2,930,856 to Toht (hereinafter, "Toht").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first or third criteria.

Lack of all Claim Limitations

Claim 1, as amended, requires a connector physically coupling the behind-the-car component to the completely-in-canal component, ... wherein the connector is designed to include a portion of the connector within the ear canal of the user, and said connector being sufficiently rigid so as to allow said connector to be used to insert and remove the completely-in-canal component from the ear canal of the user.

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The Examiner asserts that Shennib discloses a completely-in-canal component and a connector physically coupling the completely-in-canal component to an in-the-ear component. The Examiner admits that Shennib does not show a behind-the-ear component and instead relies upon Toht as describing this limitation.

Applicant respectfully asserts that neither Shennib, nor Toht describes the limitation of claim 1 set forth above. Neither Shennib, nor Toht describe a connector physically coupling a behind-the-ear component to a completely-in-canal component, nor do they describe a connector sufficiently rigid so as to allow the connector to be used to insert and remove the completely-in-canal component from the ear canal of the user. Shennib describes a completely rigid connector that connects between the in-the-ear component of Shennib and the completely-in-canal component using articulating joints. Figures 19-20, and column 10, lines 44-58. The connector of Shennib is incapable of being connected to a behind-the-ear component and is incapable of being modified to make such a connection. The connector of Shennib is only usable with an in-the-ear component such as is shown in Shennib. Further, it is the in-the-ear component of Shennib that is used to insert and remove the completely-in-canal component from the ear canal of the user and not the connector as required by claim 1.

Similarly, the connector of Toht does not meet the limitations of claim 1 as described above. The connector of Toht connects the behind-the-ear component to the in-the-ear speaker module as shown in Figure 1. The connector of Toht does not include a portion of the connector within the ear canal of the user as required by claim 1 since the receiver 2 of Toht rests outside the ear canal of the user. Further, while Toht describes possibly employing a stiffener with the connector to allow the connector to retain its shape, Toht does not describe that the connector is sufficiently rigid so as to allow said connector to be used to insert and remove the completely-in-canal component from the ear canal of the user.

Since neither Shennib, nor Toht describe a connector physically coupling the behind-the-ear component to the completely-in-canal component, ... wherein the connector is designed to include a portion of the connector within the ear canal of the user, and said connector being sufficiently rigid so as to allow said connector to be used to insert and remove the completely-in-canal component from the ear canal of the user, as required by claim 1, the combination of Toht and Shennib fails to suggest all the claim limitations as

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required under 35 U.S.C. §103 or M.P.E.P. § 2143. Applicant respectfully asserts, therefore, that claim 1 is allowable over the rejection of record and respectfully requests such action by the Examiner.

Claim 31, as amended, requires means for physically coupling the completely-in-canal component to the behind-the-ear component, ...wherein the means for physically coupling is shaped to place a portion of the means for physically coupling within the ear canal of the user, and said means for physically coupling being sufficiently rigid so as to allow said means for physically coupling to be used to insert and remove the completely-in-canal component from the ear canal of the user. Claim 45, as amended, requires that the connector of sufficient length is shaped to place a portion of the connector within the ear canal of the user, and said connector of sufficient length being sufficiently rigid so as to allow said connector of sufficient length to be used to insert and remove the completely-in-canal component from the ear canal of the user.

For the reasons describe above with respect to claim 1, neither Shennib, nor Toht describe the limitations required by claims 31 or 45 as set forth above. Therefore, the combination of Toht and Shennib fails to suggest all the claim limitations as required under 35 U.S.C. §103 or M.P.E.P. § 2143. Applicant respectfully asserts, therefore, that claims 31 and 45 are allowable over the rejection of record and respectfully requests such action by the Examiner.

Lack of Motivation

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, the proposed modification cannot change the principle of operation of the prior art invention being modified. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) cited in M.P.E.P. § 2143.01.

The Examiner states that it would have been obvious to one skilled in the art at the time of the invention to replace the ITE components of Shennib with the BTE components of Toht. The Examiner's motivation does not address the modifications necessary to the

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connectors of Shennib or Toht that would be required to make such a combination possible. As has been described the connectors of Shennib and Toht cannot be modified in such a way as to make the connection between the BTE component of Toht and the CIC component of Shennib. The rigid connector of Shennib cannot be physically modified to traverse the path from inside the ear canal to behind the ear of the user, and the connector of Toht is designed only to bend over the top of the ear and not to be inserted into the ear canal while being sufficiently rigid to allow insertion and removal of a completely-in-canal component as the Examiner's modification would require. See, Shennib, Figures 19 and 20 and Toht, column 2, lines 3-9.

If a suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle under which the primary reference was designed to operate, then the combination does not render the claim obvious. *In re Ratti*, at 813, cited by M.P.E.P. 2143.01.

The Examiner's proposed changes require a substantial alteration of either the connector of Toht or the connector of Shennib, which cannot be accomplished without substantial alteration. Therefore, the proposed combination cannot render the rejected claims obvious under 35 U.S.C. § 103, and Applicant requests that the combination of Toht and Shennib be withdrawn by the Examiner.

Dependent Claims

Claims 2-19, 21, and 30 depend from claim 1, claims 32-39 depend from claim 31, and claims 46-47, 49, 51, 52, 54-57 and 60 depend from claim 45. Each of these claims inherit the limitations of their respective base claim and are allowable for at least the reasons described above.

Rejection under 35 U.S.C. § 103 (Toht in view of Shennib further in view of Taenzer or Rapps or Kang)

Claims 20, 40 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shennib in view of Toht and further in view of U.S. Patent No. 6,445,799 to Taenzer et al. (hereinafter, "Taenzer"). Claim 48 is rejected under 35 U.S.C. § 103(a) as being

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unpatentable over Shennib in view of Toht and further in view of U.S. Patent No. 6,101,259 to Rapps (hereinafter, "Rapps"). Claims 58 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shennib in view of Toht and further in view of U.S. Patent No. 5,757,935 to Kang et al. (hereinafter, "Kang").

Claims 20 depends from claim 1, claim 40 depends from claim 31, and claims 48, 50, 58 and 59 depend from claim 45. Each of these claims inherit the limitations of their respective base claim and are allowable for at least the reasons set forth with respect to claims 1, 31 and 45, respectively.

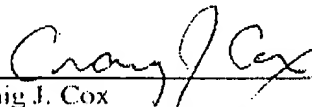
Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 59184/P002US/10026564 from which the undersigned is authorized to draw.

Dated: January 27, 2006

Respectfully submitted,

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